REMARKS

Claims 1-10 were originally filed in this application. In this Response, no claims have been amended, cancelled, or added. Accordingly, claims 1-10 are currently under consideration.

Double Patenting

Claims 1-10 stand rejected under the judicially created doctrine of double patenting over claims 1, 11, 12, and 29 of U.S. Patent No. 6,132,823. Applicant will reply to this rejection when allowable subject matter has been indicated. Until then, Applicant has no way of knowing whether a rejection under judicial double patenting is proper or whether submission of a terminal disclaimer under 37 C.F.R. §1.321 would be appropriate.

Rejections under 35 U.S.C. §102

Claims 1 and 6

Claims 1 and 6 stand rejected under 35 U.S.C. §102(a) as anticipated by U.S. Patent Nos. 4,857,675 to Marancik *et al.* ("Marancik") and 5,450,266 to Downie ("Downie"). With respect to Marancik, the Office Action states that "Marancik cleary teaches that the 'objects of the invention are to attain a high heat transfer', which the examiner believes would read on the instantly claimed invention." With respect to Downie, the Office Action asserts that "Downie clearly teaches an 'enhanced heat transfer surface' which the examiner believes would read on the instantly claimed invention."

Applicant strongly contends with the Examiner's reasoning set forth in support of the §102 rejections. To be anticipatory, a reference must teach each and every element of the claimed invention. Claim 1 recites more than one element. That is, claim 1 recites a "heat transfer surface" and, that the heat transfer surface has a "thermal conductivity substantially greater than silver." As noted in Applicant's previous response, both Marancik and Downie fail to teach or disclose a heat transfer surface having a thermal conductivity substantially greater than silver.

The Examiner states that Marancik and Downie teach "high" or "enhanced" heat transfer surfaces, respectively. However, neither Marancik nor Downie teach that these heat transfer surfaces have a thermal conductivity substantially greater than silver. Having a thermal conductivity substantially greater than silver is one of the elements of currently rejected claim 1, but the Examiner fails to point out where this element is taught or disclosed in either the Marancik or Downie references. Indeed, while the Examiner notes that Claim 1 requires a "heat transfer surface with a thermal conductivity greater than silver," he fails to set forth where such a heat transfer surface is taught or disclosed in the art made of record.

A "high heat transfer" and an "enhanced heat transfer surface" are not sufficient disclosures of a heat transfer surface with a thermal conductivity greater than silver, and these disclosures do not read upon the instant claims. Instead, a reference must disclose the "identical invention" in "as complete detail as contained in the claim" in order to be considered anticipatory. *Richardson v. Suzuki Motor Co.* 868 F. 2d 1226, 1236, 9 USPQF2d 1913, 1920 (Fed. Cir. 1989). Having a thermal conductivity substantially greater than silver is not synonymous with a "high heat transfer" or an "enhanced heat transfer surface." If the Examiner is seeking to rely on inherency to support the current rejections, those arguments, and the supporting evidence, should be clearly set forth. Such supporting evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *See* MPEP 2131.02 (III); *Continental Can Co. USA v. Monsanto Co.*, 948 F. 2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Additional explanation, much more, is needed in order to support this rejection.

Similarly, one of the elements of claim 6 is a heat transfer surface "having a thermal conductivity which substantially increases above an activation temperature." This is in contrast to the Examiner's assertion that, "[c]laim 1 (and 6) only requires a heat transfer surface with a thermal conductivity greater than silver." *See* Office Action, pg 3. Claim 6 is not identical to claim 1, as each claim contains separate and distinct elements. Accordingly, having a thermal

conductivity that substantially increases above an activation temperature must be taught or disclosed by the references for claim 6 to be considered anticipated.

However, for reasons similar to those set forth above, claim 6 is not anticipated by Marancik or Downie. That is, the Examiner fails to set forth with specificity, the reasons he believes that a "high heat transfer" or an "enhanced heat transfer surface" read upon the instant claims. Facially, they do not.

The rejections under 35 U.S.C §102 are improper and should be withdrawn.

Improper Final Rejection

Applicant requests that the finality of the instant Action be withdrawn because it has not properly been made final. An Office Action can not properly be made final where the Examiner introduces a new ground of rejection that was not necessitated by the Applicant's amendment. *See* MPEP §706.07(a). Here, the Examiner has introduced a new rejection of claim 6 under 35 U.S.C. §102. With respect to this rejection, the Examiner states, "***due to an inadvertent error***, the examiner rejected claim 5 and not independent claim 6" (emphasis added). Therefore, the Applicant did not necessitate the new rejection of claim 6.

The finality of the Office Action is improper, and should be withdrawn.

CONCLUSION

Applicant has responded to each matter of substance raised in the outstanding Office Action. Accordingly, reconsideration and allowance of the pending claims is respectfully requested. If a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 458172000100.

Respectfully submitted,

Dated: February 7, 2003 By: _____

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